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In re Application of
TEITELBAUM *et al*
U.S. Application No.: 10/534,055
PCT No.: PCT/US03/09285
Int. Filing Date: 25 March 2003
Priority Date: None
Docket No.: 64118.000192
For: TRANSPEDICULAR
INTERVERTEBRAL DISK ACCESS
METHODS AND DEVICES

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DECISION ON
PETITION
UNDER 37 CFR 1.47(a)

This is a decision on applicants' "Petition Under 37 C.F.R. §1.47(a)" filed 23 November 2005.

BACKGROUND

On 25 July 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath/declaration in compliance with 37 CFR 1.497(a) and (b) must be provided. Applicants were given two months to respond with extensions available.

On 23 November 2005, applicants submitted a response which was accompanied by, *inter alia*, the subject petition and petition fee of \$130.00; the surcharge fee of \$130.00; a two-month extension fee of \$450.00; a declaration executed by six of the seven named inventors; a declaration of Yison Song; and attachments A - C.

DISCUSSION

Petitioners allege that "nonsigning inventor Frank Nguyen is unavailable" and filed a petition under 37 CFR 1.47(a) as a response to the Form PCT/DO/EO/905.

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor refuses to execute the application or cannot be found or reached after diligent effort; (3) a statement of the last known address of the missing joint inventor; (4) and an oath or declaration executed by

the signing joint inventor on his behalf and on behalf of the nonsigning joint inventor.

Concerning item (1), the fee for a petition under 37 CFR 1.47 changed to \$200.00 on 08 December 2004. Petitioners submitted a \$130.00 petition fee. The \$70.00 difference will be charged to Deposit Account No. 50-0206 as authorized satisfying item (1).

Regarding item (2), the 37 CFR 1.47(a) applicants submitted evidence filed previously in an earlier U.S. application (10/999,216) showing that a diligent effort was made to locate Mr. Nguyen. A review of this evidence shows that a letter dated 04 April 2005 was sent to the last known address of Mr. Nguyen in Superior, Colorado. This "package was undeliverable and marked Return to Sender." See Atch. A.

However, petitioners also submitted a copy of a letter dated 25 October 2005 in the subject application which was signed as **received by Frank Nguyen at the Colorado address on 01 November 2005**. See Atch. C.

Consequently, petitioners' assertion that Mr. Nguyen cannot be located is in question. Petitioners must determine if the nonsigning inventor still lives in Superior, Colorado. Petitioners may then claim that Mr. Nguyen is refusing to cooperate, but a complete copy of the subject application must be sent to the nonsigning inventor to make this assertion. See § 409.03(d) MPEP.

For these reasons, item (2) of 37 CFR 1.47(a) is not satisfied.

With regard to item (3), the 37 CFR 1.47(a) applicants indicated two possible addresses for the nonsigning inventor. This item should be updated if it is determined that the nonsigning inventor still resides in Colorado.

Concerning item (4), petitioners included a declaration signed by six of the seven joint inventors listed on the international publication. The nonsigning co-inventor's name, residence, post office address and citizenship are typed on the declaration. Nevertheless, the declaration does not meet the requirements of 37 CFR 1.497(a) and (b).

It appears that petitioner submitted one complete declaration for the first inventor and copies of the signing pages for the five other named inventors. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. By providing only a partial declaration for five of the named inventors, it is not clear what inventive entity was listed on the declaration signed by each co-inventor. Applicants

must submit the complete declaration signed by each co-inventor. For this reason, item (4) of 37 CFR 1.47(a) is not satisfied.

Thus, all of the requirements of 37 CFR 1.47(a) are not yet complete.

CONCLUSION

The petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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